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Markman v. Westview Instruments, Inc.--U.S.--, 116 S.Ct. 1384 (1996)

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CASE SUMMARIES

Markman v. Westview Instruments, Inc.

--- U.S. ---, 116 S.Ct. 1384 (1996)

INTRODUCTION

Plaintiff, Herbert Markman, brought a patent infringement claim against defendant, Westview Instruments, for its use of Markman's inventory control method for dry cleaning. The United States District Court for the Eastern District of Pennsylvania entered judgment for Westview, despite the jury's finding of infringement.[1] The Court of Appeals for the Federal Circuit affirmed, holding the interpretation of a patent's claim terms to be the exclusive province of the court.[2] *Certiorari* was granted. The Supreme Court affirmed and concluded that judges and not juries should decide the scope of a patent.[3] As a result, the construction of a patent, including any term of art within its claim, is now reserved for a judge's determination. In its unanimous decision, the Court cited judicial expertise and uniformity as the basis for its decision.[4]

FACTS

Markman owns United States Reissue Patent No. 33,054 for his "Inventory Control and Reporting System for Drycleaning Stores."[5] The patent describes a system that can monitor and report the status,

1. Markman v. Westview Instruments, Inc., -- U.S. --, 116 S.Ct. 1384 (1996).
2. *Id.*
3. *Id.*
4. *Id.*
5. *Id.* at 1388.

location and movement of clothing in a dry cleaning establishment.[6] The Markman system consists of a keyboard and data processor which generates written records for each transaction. These records include a bar code that employees can use to log the progress of clothing throughout the dry cleaning process.[7] Westview's product also includes a keyboard and processor. It also lists charges for the dry cleaning services on bar-coded tickets that can be read by portable optical detectors.[8]

Markman brought an infringement suit against Westview and Althon Enterprises, an operator of dry cleaning establishments using Westview's products (collectively,"Westview"). Westview responded that Markman's patent is not infringed by Westview's system because the latter functions merely to record an inventory of receivables by tracking invoices and transaction totals, rather than recording and tracking an inventory of articles of clothing.[9] Part of the dispute hinged upon the meaning of the word "inventory," a term found in Markman's claim, which states that Markman's product can "maintain an inventory total" and "detect and localize spurious additions to inventory."[10] The case was tried before a jury who listened to expert witness testimony about the meaning of "inventory" and other claim language.[11]

After the jury compared Markman's patented system to Westview's device, it found an infringement of Markman's patent.[12] The district court nevertheless granted Westview's motion for judgment as a matter of law. The court reasoned that the term "inventory" in Markman's patent encompassed "both cash inventory and the actual physical inventory of articles of clothing."[13] Under the trial court's construction of the patent, the production, sale or use of a tracking system for dry cleaners would not infringe Markman's patent unless

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6. *Id.*
7. *Id.*
8. *Id.*
9. *Id.*
10. *Id.*
11. *Id.*
12. *Id.*
13. *Markman*, 116 S.Ct. at 1388 (quoting Markman v. Westview Instruments, Inc., 772 F. Supp. 1535, 1537-1538 (E.D.Pa. 1991)).

the product was capable of tracking articles of clothing throughout the cleaning process and generating reports about their status and location.[14] Since Westview's system cannot perform these tasks, the district court directed a verdict on the ground that Westview's device does not have the "means to maintain an inventory total" and thus cannot "detect and localize spurious additions to inventory as well as spurious deletions therefrom," as required by Markman's claim.[15]

Markman appealed, arguing it was error for the district court to substitute its construction of the disputed claim term "inventory" in place of the jury's construction.[16] The United States Court of Appeals for the Federal Circuit affirmed, holding that the interpretation of claim terms are within the exclusive province of the court. Moreover, the court found the purpose of the Seventh Amendment to be consistent with its conclusion.[17] Subsequently, the Supreme Court granted *certiorari.*

LEGAL ANALYSIS

The issue before the Court was whether the interpretation of a patent claim is a matter of law reserved entirely for the court or subject to the Seventh Amendment guarantee that a jury will determine the meaning of any disputed term of art about which expert testimony is offered.[18] A patent claim is the portion of a patent document that defines the scope of the patentee's rights. The Court held that the construction of a patent, including terms of art within its claim, is exclusively within the province of the court.[19]

The United States Supreme Court approached the issue in three steps. First, the Court examined the history of patent infringement claims and determined that the Seventh Amendment required a trial by jury.[20] Second, the Court looked to common law practice at the

14. *Id.*
15. *Id.* (quoting *Markman*, 772 F. Supp. at 1537).
16. *Markman*, 116 S.Ct. at 1388.
17. *Id.* (citing Markman v. Westview Instruments, Inc., 52 F.3d 967 (1995)).
18. *Markman*, 116 S.Ct. at 1384.
19. *Id.*
20. *Id.*

time the Seventh Amendment was adopted and determined that common law did not require that a jury, rather than a judge, interpret all claims and terms of art.[21] Third, the Court weighed case law precedent, the relative interpretive skills of judges and juries and the importance of uniformity in the treatment of patents to reach its conclusion.[22]

I. THE SEVENTH AMENDMENT

The Court first examined the history of patent infringement cases. The Court acknowledged that the Seventh Amendment right to a trial by jury is a right which existed under the English common law when the amendment was adopted.[23] Thus, the first question for the Court was whether infringement cases were analogous to a cause of action that was tried at law.[24] The Court noted that currently there is no dispute that infringement cases must be tried before a jury, as disputed by prior courts.[25]

This conclusion led the Court to address a second question: whether a patent claim's construction was necessarily a jury issue.[26] The Court reasoned that it must compare modern practice to historical sources. The Court concluded that where there is no exact antecedent in the common law, the modern practice should be compared to earlier practices. The best analogy that can be drawn between the old and the new must be sought.[27] Accordingly, the Court shifted its analysis to common law practice at the time the Seventh Amendment was adopted.[28]

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21. *Id.*
22. *Id.*
23. *Id.* at 1386. *See, Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657 (1935).
24. *Markman*, 116 S.Ct. at 1386.
25. *Id.*
26. *Id.*
27. *Id.*
28. *Id.*

II. COMMON LAW PRACTICE

The Court found that there is no direct antecedent of modern claim construction in historical sources.[29] The closest 18th-century analogue to modern claim construction is the construction of patent specifications describing an invention. Early patent cases from England and the United States courts show that judges, not juries, construed specification terms.[30] The Court concluded that no authority from this period supported Markman's contention that the task of defining terms of art in a specification fell within the jury's province.[31]

III. ALLOCATION

The Court found that common law practice at the time of the framing of the Seventh Amendment did not entail application of the Seventh Amendment's jury guarantee to the construction of the claim document. Therefore, the Court looked elsewhere to determine how to allocate the responsibility for the construction of a patent between a court or jury. Accordingly, the Court consulted precedent and considered both the relative interpretive skills of judges and juries and the policies that ought to be furthered by the allocation.

A. Precedent

First, the Court looked to precedent. The Court explained that the two elements to consider in a patent case are: (1) the construction the patent and (2) a determination of infringement.[32] The first element is a question of law to be determined by a court by "construing the letters-patent, and the description of the invention and specification of claim annexed to them."[33] The second element is a question of

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29. *Id.*
30. *Id.*
31. *Id.*
32. *Id.* at 1393.
33. *Id.* (quoting Winans v. New York & Erie R. Co., 21 How. 88, 100, 16 L.Ed. 68 (1859)). *See also Winans v. Denmead*, 15 How. 330, 338, 14 L.Ed. 717 (1854);

fact for the jury.[34]

In arguing for a different allocation of responsibility for the first question, Markman relied on two cases: *Bischoff v. Wethered*[35] and *Tucker v. Spalding*.[36] Markman asserted that these cases show that evidence of the meaning of patent terms was offered to 19th-century juries. Markman argued further that this conclusion implied that the meaning of a documentary term was a jury issue whenever it was subject to evidentiary proof.[37]

The Court rejected Markman's claim. The court reasoned that *Bischoff* is a case in which a distinction was made between issues of document interpretation and product identification and held that expert testimony was properly presented to the jury on the ultimate issue of that case, whether the physical objects produced by the patent were identical.[38] The Court did not see the decision as bearing upon the appropriate treatment of disputed terms.

Similarly, the Court dismissed Markman's reliance on *Tucker*. The Court acknowledged that the reasoning in that case relied expressly on *Bischoff*, and the case clearly noted that it was for the Court to "lay down to the jury the law which should govern them."[39] In sum, the Court reasoned that neither *Bischoff* nor *Tucker* indicated that juries must resolve the meaning of terms of art in construing a patent, and neither case undercut precedent.[40]

B. Functional Considerations

Since precedent provided no clear answers, the Court next turned to functional considerations to determine whether a judge or jury should define terms of art.

The Court noted that "the construction of written instruments is one

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Hogg v. Emerson, 6 How. 437, 484, 12 L.Ed 505 (1848); *cf. Parker v. Hulme*, 18 F. Cas. 1138, 1140 (No. 10, 740) (CC E.D. Pa. 1849).

34. *Id.*

35. 76 U.S. 812 (1870).

36. 80 U.S. 453 (1872).

37. *Markman*, 116 S.Ct. at 1394.

38. *Id.*

39. *Id.* (quoting Tucker, 76 U.S. at 455).

40. *Markman*, 116 S.Ct at 1395.

of those things that judges often do and are likely to do better than jurors unburdened by training in exegesis."[41] In particular, patent construction is a special occupation requiring, like all others, special training and practice. A judge, with his training and discipline, is more likely to give a proper interpretation to such instruments than a jury would.[42]

Markman argued that a jury should decide a question of meaning peculiar to a trade or profession because that issue involves testimony requiring credibility determinations which are characteristically a jury determination.[43] The Court conceded that credibility judgments have to be made about the experts who testify in patent cases. However, the Court reasoned that such credibility determinations will be subsumed within the sophisticated analysis of the whole document required by the standard construction rule that a term can be defined only in a way that comports with the instrument as a whole.[44] The Court reasoned further that a jury's capabilities to evaluate demeanor, to sense the "mainsprings of human conduct"[45] or to reflect community standards[46] are much less significant than a judge's trained ability to evaluate the testimony in relation to the overall structure of the patent.[47] In other words, the decision maker vested with the task of construing the patent is in a better position to ascertain whether an expert's proposed definition fully comports with the specification and claims and consequently is better able to preserve the patent's internal coherence. The Court concluded that there is sufficient reason to treat the construction of terms of art like many other responsibilities given to a judge in the normal course of trial.[48]

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41. *Id.*

42. *Id.* (citing Parker v. Hulme, 18 F.Cas. at 1140).

43. *Markman*, 116 S.Ct. at 1395.

44. *Id. See also, Bates v. Coe*, 98 U.S. 31, 38 (1878); *cf. U.S. Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp.*, 315 U.S. 668, 678 (1942).

45. *Markman*, 116 S.Ct at 1395 (citing Commissioner v. Duberstein, 363 U.S. 278, 289 (1960)).

46. *Markman*, 116 S.Ct. at 1395 (citing United States v. McConney, 728 F.2d 1195, 1204 (C.A.9 1984) (*en banc*)).

47. *Id.*

48. *Markman*, 116 S.Ct. at 1395.

C. Uniformity

Finally, the Court addressed the importance of uniformity in the treatment of a given patent. The Court cited uniformity as an independent reason to allocate all issues of construction to the court.[49] The Court noted that Congress created the Court of Appeals for the Federal Circuit as an exclusive appellate court for patent cases,[50] observing that increased uniformity would "strengthen the United States patent system in such a way as to foster technological growth and industrial innovation."[51]

The Court reasoned that uniformity would be ill served by submitting issues of document construction to juries.[52] Allocating questions of document construction to a jury would not necessarily leave evidentiary questions of meaning wide open in every new court in which a patent might be litigated, for principles of issue preclusion would ordinarily foster uniformity.[53] The Court reasoned further that where issue preclusion cannot be asserted against new and independent infringement defendants even within a given jurisdiction, treating interpretive issues as purely legal will promote inter-jurisdictional certainty through the application of *stare decisis* on those questions not yet subject to inter-jurisdictional uniformity under the authority of the Federal Circuit Court.[54] The United States Supreme Court concluded that uniformity would be encouraged by allocating all issues of construction to the sole discretion of the court.[55]

CONCLUSION

The United States Supreme Court held that the construction of a

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49. *Id.*

50. *Id.* (citing H.R. Rep. No. 97-312, pp. 20-23 (1981)).

51. *Markman*, 116 S.Ct. at 1395 (citing H.R. Rep. No. 97-312 at 20).

52. *Markman*, 116 S.Ct. at 1395.

53. *Id.* (citing Cf. Blonder-Tongue Laboratories, Inc. v. University of Ill. Foundation, 402 U.S. 313 (1971)).

54. *Markman*, 116 S.Ct. at 1395.

55. *Id.*

patent, including any term of art within its claim, is exclusively within the province of the court.[56] The Court looked to the history of patent infringement actions, common-law practice at the time the Seventh Amendment was adopted and precedent and policy implications to reach its conclusion.

This decision is controversial in light of the inconclusive historical precedent regarding the application of the Seventh Amendment right to a jury trial. However, the advantages of the decision are clear. The decision will grant judges, who are often more learned in the interpretation of patent claims than juries, the power to give meaning to terms of art in patent claims. In addition, the decision will promote uniformity in the treatment of patents. Finally, the decision will encourage patentees like Markman to specify the scope of invention in a given patent, to secure to the patentee all rights to which the patentee is entitled and to apprise the public of what subject matter is not yet patented.

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56. *Id.*